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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/567,755 | 02/10/2006 | Thomas Ficker | 017P0078WOUS | 5362 |
| 36608 7590 04/14/2010 GUIDRUN E. HUCKETT DRAUDT SCHUBERTSTR. 15A WUPPERTAL, 42289 GERMANY | | | | |
| EXAMINER | | | | |
| CHANG, RICK KILTAE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3726 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/14/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,755

Applicant(s)

FICKER ET AL.

Examiner

Rick K. Chang

Art Unit

3726

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 17 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 2/10/06

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I and Species 2 in the reply filed on 12/28/09 is acknowledged. The groups listed in the restriction do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the groups lack the same or corresponding special technical features for the following reasons: in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of at least DE 195 26 900 and Connell et al (US 3,867,751).

Specifically, it is noted that the features which are common to all of the claims are as follows: DE 195 26 900 discloses profiled rings, roll forming. DE 195 26 900 discloses generating during roll forming a counterforce generated during roll forming (the tube (1) thickness became thicker from Fig. 1 to Fig. 2. The roll forming process generates a counterforce relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a profile to be shaped on the ring as shown in Fig. 2). Furthermore, Connell et al (US 3,867,751) teaches generating during roll forming a counter force relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a profile to be shaped on the ring (Connell discloses 10 and 40 in Figs. 1A and 2A became thicker and wider in Figs. 1D and 2D).

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed 2/10/06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there is no English translation of the non-English references. Non-English references have not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(c). See MPEP § 609.05(a).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-12 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are numerous phrases and clauses in the claims that are vague, indefinite, and/or awkwardly and confusingly worded, and therefore, are not fully understood. The following are examples:

Claim 11, line 6: "roll forming" lacks positive antecedent basis.

Claim 11, line 7: "material" lacks positive antecedent basis.

Claim 11, line 10: "the ring" lacks positive antecedent basis.

Claim 12, line 2: “rolling bearing rings” and “transmission rings” lack positive antecedent basis. Are they referring to “profile rings” in claim 11, line 2 or “the ring” in claim 11, line 10? Should this part of the claim include “at least one of” before “rolling bearing rings” and “transmission rings”?

Claims are ambiguous and competitors would be unable to discern the bounds of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11-12 and 17, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by DE 195 26 900.

Re claim 11: DE 195 26 900 discloses combining machine-cutting processes and forming processes (Figs. 1-6 and 8-9) with one another sequentially, parallel, or sequentially and parallel, wherein one of the forming processes is roll forming (Figs. 1-6 and 8-9);

generating during roll forming a counterforce relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a profile to be shaped on the ring (during roll forming, the tube (1) thickness became thicker from Fig. 1 to Fig. 2. The roll forming process generates a counterforce relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting

material is controlled such that flowing material is integrated into a profile to be shaped on the ring as shown in Fig. 2).

Re claim 12: since DE 195 26 900 discloses all the claimed limitations as stated above, the profiled rings provided by DE 195 26 900 must be rolling bearing rings and transmission rings in completely grinding-ready state.

Re claim 17: DE 195 26 900 discloses at least one of an inner profiling and an outer profiling of the rings is performed with a single clamping action (Figs. 2 and 9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-12 and 17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 195 26 900 in view of Connell et al (US 3,867,751).

DE 195 26 900 discloses combining machine-cutting processes and forming processes (Figs. 1-6 and 8-9) with one another sequentially, parallel, or sequentially and parallel, wherein one of the forming processes is roll forming (Figs. 1-6 and 8-9) and the profiled rings provided by DE 195 26 900 must be rolling bearing rings and transmission rings in completely grinding-ready state, except for generating during roll forming a counterforce relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a

profile to be shaped on the ring. DE 195 26 900 discloses at least one of an inner profiling and an outer profiling of the rings is performed with a single clamping action (Figs. 2 and 9).

Connell discloses generating during roll forming a counter force relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a profile to be shaped on the ring (Connell discloses 10 and 40 in Figs. 1A and 2A became thicker and wider in Figs. 1D and 2D).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify DE 195 26 900 by generating during roll forming a counterforce relative to a flow direction of the starting material so that a material flow in at least one of an axial direction and a radial direction of the starting material is controlled such that flowing material is integrated into a profile to be shaped on the ring, as taught by Connell, for the purpose of preventing brittleness and fracture.

Allowable Subject Matter

9. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity (optional).

Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (571) 272-4564. The examiner can normally be reached on 5:30 AM to 1:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rick K. Chang/
Primary Examiner, A.U. 3726

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April 14, 2010